

**PATENT APPLICATION**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re application of

Docket No: Q63180

Kazuhiro KUSUDA

Appln. No.: 09/783,096

Group Art Unit: 3714

Confirmation No.: 4487

Examiner: Corbett B. Coburn

Filed: February 15, 2001

For: HORSE RACING GAME WITH VARIED TRACK ATTRIBUTES

**APPEAL BRIEF UNDER 37 C.F.R. § 41.37**

**MAIL STOP APPEAL BRIEF - PATENTS**

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

In accordance with the provisions of 37 C.F.R. § 41.37, Appellant submits the following:

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**I. REAL PARTY IN INTEREST**

In compliance with 37 C.F.R. § 41.37, paragraph (c)(1)(i), based on information supplied by Appellant, and to the best of Appellant's legal representatives' knowledge, the real party in interest is the assignees, KONAMI CORPORATION.

**II. RELATED APPEALS AND INTERFERENCES**

In compliance with 37 C.F.R. § 41.37, paragraph (c)(1)(ii), Appellant, as well as Appellant's legal representatives, state that they are not aware of any other prior and pending appeals, interferences or judicial proceedings which may be related to, may directly affect or may be directly affected by or have a bearing on the Board's decision in the pending appeal.

### **III. STATUS OF CLAIMS**

In compliance with 37 C.F.R. § 41.37, paragraph (c)(1)(iii), Appellant hereby states that claims 1-4, 6, 8-11, 13, 15-18, 20 and 22-29 are currently pending. No claims are allowed.

Appellant has appealed from the final rejection of claims 1-4, 6, 8-11, 13, 15-18, 20 and 22-29.

These claims, as finally rejected, are set forth in the attached Appendix.

#### **IV. STATUS OF AMENDMENTS**

In compliance with 37 C.F.R. § 41.37, paragraph (c)(1)(iv), Appellant hereby states that an Amendment under 37 C.F.R. § 1.116 and Notice of Appeal were filed on **May 22, 2006**, in response to a first Office Action final rejection dated November 22, 2005. The Amendment did not amend any claims but simply asserted the patentability of the claims over their final rejection and the impropriety of the finality of the rejection. In an Advisory Action dated June 7, 2006, the Examiner did not indicate whether or not the amendment was entered for purposes of appeal.

An Amendment under 37 C.F.R. § 1.114(c) was filed on **October 28, 2005** in conjunction with the filing of an RCE and in response to the final rejection dated March 30, 2005. New claims 27-29 were added and the Amendment was entered.

An Amendment under 37 C.F.R. § 1.111 was filed on **January 18, 2005** in response to an Office Action dated July 21, 2004. Independent claims 1, 8 and 15 were amended and new claims 24-26 were added. The Amendment was entered.

An Amendment under 37 C.F.R. § 1.116 dated **January 28, 2004**, which was entered by an RCE dated April 27, 2004, was filed in response to an Office Action dated October 28, 2003. The Amendment added limitations to independent claims 1, 8 and 15, and cancelled claims 5, 12 and 19.

An Amendment filed on **October 6, 2003** in response to the Office Action dated June 6, 2003 did not add or amend claims and was entered.

Appeal Brief under 37 C.F.R. § 41.37  
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An Amendment under 37 C.F.R. §1.116 filed on **February 26, 2003** in response to a final Office Action dated November 1, 2002, amended claims 1-6, 8-13, 15-20 and 22 and cancelled claims 7, 14 and 21. Although the Examiner refused entry in an Advisory Action dated March 7, 2003, the Amendment was entered on the basis of an RCE filed on April 1, 2003.

An Amendment under 37 C.F.R. § 1.111 filed on **August 19, 2002** in response to an Office Action dated May 20, 2002, amended claims 1, 5, 8 and 15, and was entered.

**V. SUMMARY OF THE CLAIMED SUBJECT MATTER**

Claims 1, 8, 15 and 22, which define different aspects of the invention, are the only independent claims.

The invention generally is directed to a computerized game system with a racing field formed on a board and comprising a plurality of field regions or tracks concurrently existing on the board on which a plurality of running models can run, each running model having inherent ability parameters that vary in accordance with a given environment. The term “given environment” is defined at page 3, lines 20-22 and, for purposes of the claimed invention, differentiates among running environments (turf region, dirt region, etc.). The “inherent ability parameters” are assigned in advance and a “running model runs, based on the current ability parameters,” as defined at page 3 lines 22-page 4, line 2, and changes in accordance with stamina, speed, weight, character, and the like (page 8, lines 16-25). Each running model can run on different field regions and is provide with variable factors with respect to the ability parameter, the factors differing for different running models. The factors may relate to the type of track or field region, and may be compatible with steady running, obstacle, turf or dirt courses.

According to a first embodiment, the running models in the computerized game are “physical” models that run on a board having plural tracks and have ability parameters that vary according to the running environment. The model has a control device for moving a running mechanism (page 8, lines 9-11). Importantly, any single running model can run on any of the plurality of field regions. (Summary – third aspect at pages 4-6). A physical passageway formed between the tracks permit a given running model to enter and exit between the tracks and run in different races under different conditions (page 5, line 22-page 6, line 9; page 11, line 23-page 12, line 6).

According to a second embodiment, an electronic racing device on an electronic field, rather than a mechanically constructed field, also is envisioned, as disclosed at pages 6, line 10-page 7, line 4 and page 23, line 16-page 24.

The computer-controlled arrangement for both embodiments, as illustrated schematically in Fig. 4 and described at pages 15-16, uses a main controller 61 that is coupled to storage devices for race horse data 63 and player data 64, and interfaces with a station controller 62 so that users at a plurality of stations 20 can participate in the horse race game. The main controller 61 is coupled to a communication unit 65 that, in an exemplary embodiment, will control the physical racing models.

**Independent Claim 1**

Support in the specification and Figures for the limitations of the computerized game system of claim 1 are as follows:

(1) A “racing field” 10 is formed on a predetermined board, and has a plurality of “tracks” 12, 13 concurrently existing on the board (Fig. 1; page 10 line 3-page 11, line 22; page 22, line 22-page 23, line 4). The “tracks” 12, 13 are separate and distinct areas on the common racing field 10 that have different characteristics, i.e., running environments (dirt or turf) (Fig. 1, pages 10, 11, 22 and 23). For example, at least as defined in dependent claims, one track maximizes steady running while the other obstructs steady running.

(2) The “running model,” runs a race on the racing field in accordance with the respective conditions of the respective tracks. The “running model” in the preferred embodiment is a racehorse that runs a race on a predetermined track and has a running mechanism (page 8, lines 1-15). According to claim 1, this is a “physical model” and not a mere electronic representation. The same physical running model can run in races on the plurality of tracks. In the preferred embodiment, the physical models are of a racehorse (although other racing models such as cars or cycles could be used in different track and field environments; page 24, lines 3-14).

(3) The running model is assigned an “inherent ability parameter” that varies in accordance with the “given environment,” such that the running ability changes in accordance with the ability parameters. The ability parameters include variables, such as stamina, speed and other characteristics, and change in accordance with a given environment, as explained at page 8, line 16-28. As taught at pages 8-12 and 19-23, the assignment of ability parameters to individual running models includes parameters related to the type of track. A single running model can be

used for running on multiple tracks, giving clear cost and operational advantages (page 6, lines 2-9 and page 11, line 27-page 12, line 6).

(4) A “physical passageway” is formed between the plurality of concurrently existing tracks 12, 13. The running model can enter and exit the passageway between the tracks so that the same running model can run on races on the plurality of tracks (page 5, line 23-page 6, line 9; page 11, line 23-page 12, line 3). As would be understood by one skilled in the art from the foregoing description, the ability parameter for an individual running model is changed according to the movement of the running model from one of the plurality of tracks to another through the physical passageway.

**Independent Claim 8**

Claim 8 contains a recitation of a racing field, physical running model and plural tracks concurrently on a board, as well as a definition of a physical passageway, and the change in ability parameter by movement of the running model through the passageway that is substantially identical to the recitation in claim 1. Claim 8 differs from claim 1 by specifying the running model has “variable factors of the ability parameters,” the variable factors differing in accordance with running of the running model on respective tracks. This feature is taught generally at pages 10-11, specifically page 10, lines 10-12, and the association of a running model with various inherent ability parameters is taught at pages 8-9.

**Independent Claim 15**

Claim 15 also contains a recitation of a racing field, physical running models and plural tracks concurrently on a board, as well as a definition of a physical passageway and the change in ability parameter by movement of the running model through the passageway that is substantially identical to the recitation in claim 1. Claim 15 differs from claims 1 and 8 by specifying that there are a plurality of running models, and further differs from claim 1 by specifying that each of the running models is provided with variable factors of the ability parameters, the variable factors differing in accordance with running of the running model on respective tracks. This feature is taught generally at pages 10-11, specifically page 10, lines 10-

12, and the association of a running model with various inherent ability parameters is taught at pages 8-9.

**Dependent Claims 4, 11 and 18**

The specific use of both turf and dirt tracks 12, 13 in the computerized game of claims 1, 8 and 15 is illustrated in Fig. 1, and taught at pages 10, 11, 22 and 23.

**Independent Claim 22**

The specification teaches that the invention can be applied to an electronically formed game machine, using holography, for example (page 23), where the running model and field with plural tracks are images. The running image is assigned an "inherent ability" parameter, as defined at page 8, lines 16-28, which varies in accordance a "given environment." The running image would be provided as an accurate replica of a horse, car or the like in a realistic racetrack environment, where one track is turf and another is dirt. The track images are the result of processing the current ability parameter using processes differing in accordance with the respective tracks, as explained at page 10, lines 3-19. Significantly, the conditions of the soil and turf can be adjusted, as taught at page 23, line 22-page 24.

**Dependent Claim 27**

An underlying principle of the invention is that the players have available to them a plurality of tracks 12, 13 that represent different running surfaces, such as turf, dirt or steeplechase (page 22, line 22 - page 23, line 4). A further key feature of the invention is that the player may select one or more horses for his "stable," each horse having different characteristics such as stamina, speed or normal ability (page 19, lines 9-28). Further, a player can train his horse or enhance its ability by successfully running the horse in races (page 20, line 21 - page 21, line 13). In short, the game is intended to have a player engaged for a long period of time, playing with multiple horses in the stable, whose abilities are varied and changeable based upon training, success and the like. Claim 27 is based upon the use of a race selection screen as illustrated in Fig. 2 and disclosed at least at pages 12-13.

**Dependent Claim 28**

Claim 28, which requires that the ability parameters assigned to individual running models correspond to each of the plurality of tracks and are based upon prior training of the physical running model on one or more of the plurality of tracks, is based on the disclosure at least on page 11, lines 9-22 and page 22, line 22- page 23, line 4.

**Dependent Claim 29**

Claim 29, which depends from claim 1 and provides for tracks having variable and selectable turf or soil conditions, is based on the disclosure at least on page 10, line 2-page 11, line 22 and page 23, line 16- page 24.

**VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL**

In compliance with Section 41.37, paragraph (c)(1)(ii), Appellant hereby provides a concise statement listing each ground of rejection presented for review:

**1. Rejection Under 35 USC 103**

Claims 1-4, 6, 8-11, 13, 15-18, 20, 22, 24-26 and 29 are rejected under 35 U.S.C. §103(a) as being unpatentable over Fongcallaz (5,186,460) in view of Filiczkowski (5,106,098) and Nakagawa et al (EP 0757917).

**2. Rejection Under 35 USC 103**

Claims 23 and 28 are rejected under 35 U.S.C. §103(a) as being unpatentable over Fongcallaz (5,186,460) in view of Filiczkowski (5,106,098) and Nakagawa et al (EP 0757917), and further in view of Ikeda et al (6,371,854).

**3. Rejection Under 35 USC 103**

Claim 27 is rejected under 35 U.S.C. §103(a) as being unpatentable over Fongcallaz (5,186,460) in view of Filiczkowski (5,106,098) and Nakagawa et al (EP 0757917), and further in view of Girardin (4,874,177).

## VII. ARGUMENT

**ISSUE 1** - Claims 1-4, 6, 8-11, 13, 15-18, 20, 22, 24-26 and 29 are not unpatentable over Fongeallaz (5,186,460) in view of Filiczkowski (5,106,098) and Nakagawa et al (EP 0757917) under 35 U.S.C. §103(a).

### **Independent Claims 1, 8 and 15**

Independent claims 1, 8 and 15, which define different aspects of the invention, are all directed to a computerized game system and all contain common structural features, including:

- (1) a “racing field” formed on a predetermined board, and having a plurality of tracks, that are concurrently existing on the board, the “tracks” being separate and distinct areas on the common racing field as they have different characteristics, i.e., dirt or turf, that affect the performance of the running model;
- (2) a “physical running model” that actually runs on the tracks, the model having an inherent ability parameter (individually assigned to each model) and being a physical representation of a horse, car or the like; and
- (3) a “physical passageway” that is expressly formed (a) between the tracks and (b) permits the same physical running model to enter and exit between the tracks.

The independent claims have additional common and significant functional features, including:

- (1) varying an ability of each physical running model to run a race, the current ability varying according to respective tracks; and

- (2) changing an ability parameter for a given physical running model according to the physical movement of the running from one track to another through the physical passageway.

The independent claims differ in defining a variation of an ability parameter for a physical running model according to the conditions of the respective tracks (e.g., dirt or turf). The variation according to respective tracks is defined generally in claim 1 as a “current ability parameter.” Claim 8 defines the different effect of respective tracks (e.g., dirt or turf) as the provision to a running model of “variable factors of the ability parameter.” Claim 15 specifies that running models run on respective tracks based on a current ability parameter for each of plural physical running models, and further specifies that the ability parameter for each running model comprises variable factors that differ for each physical model.

The prior art does not teach or suggest individual structural limitations shared by the three independent claims, alone or in combination, or the key functional limitations shared by the three claims, or the individual characteristics of physical running models, as defined by each of the claims. In particular, there is no teaching in any of the references of a computerized game with

- Concurrently existing tracks, which are physically separated and have different track characteristics, on which physical running models are caused to run, the running being based on an ability parameter and in accordance with the environment of a respective track. The requirement for separate tracks that have different characteristics is clear from the express limitation to (1) a physical passageway that exists between the concurrently existing tracks, and (2) an ability parameter that changes on the basis of a given track, such change being disclosed as a track surface characteristic.
- A physical passageway that not only exists between concurrently existing tracks but also expressly (1) permits a running model to enter and exit and (2) thereby

run in races on plural tracks, because (3) the ability parameter is changed according to movement from one track to another.

In the absence of a teaching in any of the cited references of these several expressly supported features, the claimed invention cannot be obvious. Moreover, the three cited references are incompatible in several respects. Finally, there is no teaching or suggestion of, or motivation for, the selective combination of features from the demonstrably different game environments in the references, as proposed by the Examiner. It would require impermissible use of hindsight, based on the Appellant's own teachings, to arrive at the claimed computerized game system as claimed.

**Fongeallaz**

The Fongeallaz et al patent discloses an electronic display (Figs. 17-19) where horses (H1, H2, H3, H4) have different abilities or attributes that relate to different track conditions (col. 5, lines 40-56); however, only a single track is displayed at a given time. The track may, in fact, be a steeplechase course (col. 5, lines 63-66).

Structurally, there is no teaching or suggestion of a racing field comprising a plurality of separate tracks that concurrently exist on a board, where the tracks have conditions that affect a running model differently, as in the present invention. The term "concurrently existing" clearly means that two or more tracks exist on the racing field formed on the predetermined board at the same time. "Concurrently existing" can only mean appearance at the same time, not sequentially or at different times. A display of tracks at different times could not be "concurrently existing." At best, the patent describes the manner in which the single track, as illustrated in Fig. 13, may be controlled to simulate race conditions along a single course measured by discrete position blocks C500-C0. The patent explains at col. 4, lines 9-57 the manner in which these individual blocks may be programmed to simulate actual race conditions over a single oval track. Modifications involving a choice of track condition is mentioned at col. 5, lines 40-62.

The Examiner has asserted that the requirement for plural tracks is met by the illustration in Fig. 13 of Fongeallaz of individual "lanes" on a single track. This assertion is inconsistent with conventional use of the term "track," according to conventional definitions, as used by

Appellant and as used by Fongeallaz. Conventionally, individual “lanes” are not considered a “track” in an actual race since the horses, autos or cycles will start in a lane and change them in the course of a race on the track. The disclosure in the specification of the present application and the use of the term “track” as applied to tracks 12 and 13 are wholly consistent with the conventional definition. The Appellant’s tracks are represented by separate and distinct areas on the common racing field that have different characteristics, i.e., running environments (dirt or turf). Finally, Fongeallaz et al uses the term “track” in the conventional sense, as is clear from the disclosure at col. 2, lines 43-56 (“the horses on at least part of the track...causing the horses to move along the track as the race progresses”). Fongeallaz et al also uses the term “lane” to refer to a path for each horse on the single track, as is clear from the disclosure at col. 3, lines 55-61 (“each of the X dimensions correspond to a lane, referenced L0-L16...”). The lanes are all used at the same time, in a single race on a single track.

In addition, there is no teaching of physical running models, since the game is simply electronic and presents static images on a screen, as in Figs. 15A, 15B and 17-19.

Further, there is no teaching of a physical passageway through which physical running models may enter and exit between tracks, at least because the patent teaches only a single electronic track with no physical running models.

As to the claimed functions, there is no teaching of any running model, even if not physical, to have different ability parameters and to run on different tracks according to those parameters. There also is no teaching that an ability parameter for a running model changes according to the physical movement of the running from one track to another through a physical passageway

As Fongeallaz et al does not and would not disclose such physical features as a passageway formed between the plurality of concurrently existing tracks, or a change of ability parameters for a given running model when moving from one track to another through a passageway, as set forth in each of independent claims 1, 8 and 15, it is both deficient and incompatible with the features of the claimed invention. Indeed, Fongeallaz et al has little, if any, relevant teaching with respect to the claimed invention.

**Filiczkowski**

Filiczkowski teaches a manual board game involving cards where the goal is to accumulate points, rather than the conventional goal of finishing first (Abstract). Given this limited focus, the board does include two concurrently existing independent tracks, one labeled turf track 2 and the other a dirt track 3, which are substantially concentric, as taught in the abstract and at col. 2, lines 49-61 with respect to the illustrations in Figs. 1A and 1B. The game uses a playing piece 30, as disclosed at col. 3, lines 20-26 and illustrated in Fig. 3, but such piece is manually moved space-by-space on a track during a game. The game is played according to a variety of cards, including weather condition and horse cards, that distinguish between a turf and dirt track, as disclosed at col. 3, lines 27- 34 (Figs. 4A, 4B) and col. 3, line 59-col 4, line 9 (Figs. 8A, 8B).

Significantly, there is no teaching of a computerized game system in Filiczkowski nor even a suggestion as to how such game would be computerized. The game depends on a variety of cards that are pre-printed, pulled and played by a participant. Their entertainment value is based on the rolling of a die turn-by-turn, the manual movement of a token space-by-space, the picking and reading of a card, and completion of card instructions in a given turn. Such game approach is incompatible with a computerized game of the type disclosed and claimed in the present application, where the physical running model is "caused to run a race," not simply to move a space. In this same regard, there is no teaching of a running model that runs a race under computer control.

Further, there is no teaching of a physical passageway through which physical running models may enter and exit between tracks, at least because the patent teaches only a manual board game in which there is no need for such passageway. Further, movement from one track to another does not cause the attributes of the passive token 30 to change.

As to the claimed functions, there is no teaching of an ability of a physical running model to run a race on plural tracks under computer control, as necessarily understood from the entire claim and the individual limitations, read in light of the specification. There also is no teaching that individual tokens 30 will have different ability parameters and run on different tracks

according to those parameters, and there is no teaching that an ability parameter for a running model changes according to the physical movement of the running from one track to another through a physical passageway.

As, Filiczkowski does not and would not disclose such physical features as a passageway formed between the plurality of concurrently existing tracks, or a change of ability parameters for a given running model when moving from one track to another through a passageway, as set forth in each of independent claims 1, 8 and 15, it is both deficient and incompatible with the claimed invention. At best, Filiczkowski shows two concentric tracks on a single board, but fails even to show any operational relationship between the two tracks.

**Nakagawa et al**

The Nakagawa et al reference concerns a computerized game machine 1 in which moving objects H resembling race horses, etc., are caused to compete in running a simulated race on a playing area resembling a racing track or field 4, as illustrated in Fig. 1.

As disclosed, the field presents a plurality of selectable racecourses that vary with respect to length, direction and location of finish line, as disclosed at page 5, lines 24-56. In particular, the plurality of race courses 5a, 5b, as illustrated in Figs. 1 and 2, have a common track region that is defined by a portion of the periphery of a central separating zone 51 and a separate track portion defined inside or outside of the crescent shaped separating zone 52. As explained at page 5, lines 1-6, the course 5a is a shortened version of the course 5b, and the two tracks share a common track portion. A race is determined on the basis of which starting gate 71 and which track is selected, as disclosed at page 5, lines 7-12. The controller 31 in control unit 3 is programmed to execute individual races determined by the courses in Table 1 and number of horses in Table 2, as explained at page 8, lines 30-33.

However, there is no teaching or suggestion that the differences in the surface or type of track 5a or 5b (e.g., turf vs. dirt, etc.) may be considered in the controller 31, nor would there be a need for such consideration as there is a substantially common portion around the central

separating zone. As would be understood by one skilled in the art and familiar with horseracing, the surface assumed to exist for the two tracks must be the same.

The horses H are physical models, as illustrated in Figs. 5-8, and may have different distribution functions, such as average running speeds, sprinting abilities and running style, as explained at page 8, lines 46-52. The controller 31 may control individual movements of a horse H on the basis of those functions, as disclosed at page 8, line 34-37. However, again, the distribution functions need not consider differences in the surface or type of track 5a or 5b (e.g., turf vs. dirt, etc.), since the track surfaces must be the same.

The game field 4, as illustrated in Fig. 2 and described beginning at page 4, line 53, includes the track 5, a paddock 6 that has a waiting zone 61, and a boundary between the track and paddock in the form of two sets of gates 7 and a partition 42. There also is a pair of passageways 63a, 63b in the boundary. Horses H that are selected to participate in a race will enter the track 5 from the paddock 6 through the passageways.

However, the passageways are not disposed "between the plurality of concurrently existing tracks" nor could they be disposed in such location since the two tracks 5a and 5b share a substantial common portion of a track. Further, there is no other structure in the reference that would permit a horse to "enter and exit between the tracks."

As to the functional features of the claimed invention, it already has been noted that the reference does not teach varying an ability of each physical running model to run a race, the current ability varying according to respective tracks. While there may be different distribution functions for each horse H in the Nakagawa game, the functions do not differ according to track type or surface. Further, in the absence of a physical passageway between tracks and the absence of different features for different tracks, there cannot be a change in ability parameter (or distribution function) according to movement from one track to another through the passageway.

In short, Nakagawa fails to teach either (1) the plurality (two) of concurrent (separate and not overlapping) tracks with different characteristics or (2) the use of a passageway between the separate tracks that (a) permits a physical model to enter and exit and (b) further permits the

same model to run a race on both tracks (c) by changing physical attributes to suit the characteristics of a respective track, as claimed.

### **Bases for Patentability**

There are four bases for patentability, any one of which Appellant respectfully submits rebuts any *prima facie* basis for rejection and supports a patentable distinction of the claimed invention over the prior art, including:

- **No teaching of express claim limitations** – None of Fongeallaz et al, Filiczkowski or Nakagawa et al teaches a computerized game with a plurality of concurrently existing tracks that are necessarily separate with different characteristics for running of models in accordance with the characteristics of the respective tracks. There is no teaching in any of Fongeallaz et al, Filiczkowski or Nakagawa et al of a passageway between concurrently existing and separate tracks for entry and exit of a running model. There is no teaching of how a running model in a computerized game can have factors that differ in accordance with the running of the models on the separate tracks, yet permit the same model to run on plural tracks. These advances are only taught by the present application and are set forth in claims on appeal..
- **Incompatibility among references** – There are incompatibilities among the three references that militate against their combination. In particular, Fongeallaz et al is wholly incompatible with plural concurrently existing tracks, as it is an array display with no capability for modification to have concurrent tracks for running of models in accordance with the characteristics of the respective tracks. Filiczkowski is a manual board game with pieces that are moved manually, based on a roll of a die by a player, rather than by computerized random control generation, as in Nakagawa et al and Fongeallaz et al. The goal in Filiczkowski and the underlying function of its cards is for a player to accumulate a greatest

number of points, rather than finish first in a race, as in Fongeallaz et al or Nakagawa.

- No teaching or suggestion of modifications – None of Filiczowski, Fongeallaz et al or Nakagawa provides any relevant teaching or suggestion as to how Fongeallaz et al or Nakagawa may be modified on the basis of Filiczowski's two tracks so that there is a capability for a single running model having variable ability factors to run on different tracks. There also is no teaching as to how or why the passageway in Nakagawa et al would be placed between tracks having different characteristics, as in the claimed invention.
- No motivation – None of Fongeallaz, Nakagawa et al or Filiczowski provide any motivation for their combination. The theme of the games and their execution is different among the three references. Even if Nakagawa et al and Fongeallaz may be considered to suggest computerization of the game in Filiczowski, the result would be a game completely different from that of the claimed invention.

The Examiner's rebuttal of these arguments during prosecution falls far short of establishing that the Appellant is not entitled to a patent on the invention as claimed. The flaws in the Examiner's position are clear, particularly with respect to the failure to teach express limitations and the failure to have adequate teaching, suggestion and motivation, as subsequently detailed.

#### **The Prior Art Fails to Teach Express Claim Limitations**

As already noted, the prior art does not teach or suggest individual structural limitations, which are shared by the three independent claims 1, 8 and 15, alone or in combination. In particular, there is no teaching in any of the references of a computerized game with concurrently existing tracks, which are necessarily physically separate and have different track characteristics, on which physical running models are caused to run under computer control, the running being based on an ability parameter and in accordance with the environment of a respective track. Also, there is no teaching of a physical passageway that exists between the concurrently existing

tracks, and an ability parameter that changes on the basis of a given track, such change being disclosed as related to at least track surface characteristic. Further, there is no teaching of a physical passageway that not only exists between concurrently existing tracks but also expressly permits a running model to enter and exit and thereby run in races on plural tracks, because the ability parameter is changed according to movement from one track to another.

The deficiencies of each reference with regard to these express limitations already has been presented. These deficiencies would not appear to be disputed by the Examiner at this point, as it appears that the Examiner's position is based on extracting bits and pieces from the separate references and creating Appellant's invention. However, this creative exercise is without suggestion, teaching or motivation and in the face of incompatibilities among the references.

**The Requisite Teaching or Suggestion for Combining Three Diverse References Is Missing**

First, none of the references mentions the idea, let alone the method, of converting a board game to a computerized game. Second, the teachings of the references lead away from a concurrent display of two distinct tracks with different surface characteristics that affect a running ability of a physical running model.

Filiczowski et al is the only reference illustrating two concurrent and separate tracks that have different track surface conditions. During prosecution, the Examiner argued that "any number of board games has been transferred to computer." This is a generic statement that does not address the manner in which the specifically claimed invention, having a racing field, plural concurrently existing tracks on the field and a running model having inherent ability parameters, may be derived from a board game such as taught in Filiczowski. It must be recognized that the illustration of two concentric tracks in Filiczowski is for convenience of packaging and board access for play. Given the absence of any teaching or suggestion with respect to computerization of the game, even if the Examiner is generally correct, it is more likely that a computerized game would display only one track at a time. This is particularly true in light of the teachings of Fongellaz et al, where the track conditions may vary, but the display is only of one track at a

time, namely a two dimensional array AR which “mimics” a race track or course and the array AR is defined by X and Y dimensions (col. 3, lines 34-54). The array is taught to represent a single track in a single array. The focus of the game in Fongeallaz is on the conduct of a single race that can have plural participants, i.e., plural horses or autos.

Moreover, it would serve no useful purpose and, in fact, would detract from the enjoyment and attention of a player of a game to have a concurrent representation of plural tracks. Major portions of a display would go unused and blank if another eight to twelve lanes were added to the array to represent a second and concurrently displayed track. Unlike the present invention where the racing field has plural concurrently existing tracks and provides an attractive realistic environment, the simulated array is nothing but a group of rows of display elements where the addition of more unused rows would give no further sense of a track environment or provide more excitement or enjoyment. Indeed, no one would be led to creating such array since it would not provide any added marketable or useful features to a purchaser.

On the basis of the foregoing, rather than suggesting a combination of the two references, Appellant submits that Fongeallaz is incompatible with plural concurrently existing tracks. Specifically, the physical and electronic arrangement in Fongeallaz is incompatible with a concurrent display of two tracks. Fongeallaz uses a primitive two-dimensional array. The focus of the game is on a single race. There is no teaching or suggestion as to how a race on one track may be displayed while a second unused track would also be displayed concurrently. Not only is there no concurrent display, such display would be highly undesirable, as it would present a serious detraction and a confusing arrangement in the Fongeallaz device.

In short, the basic arrangement of Fongeallaz teaches away from and would be incompatible with a key feature of the claimed invention.

Nakagawa does not remedy this inconsistency, or otherwise provide the necessary teaching or suggestion for a combination of the references. Nakagawa teaches a track arrangement that shares running space, rather than an arrangement where the tracks are concurrently presented and are separate and independent. Indeed, the compact design used by Nakagawa teaches away from two separate and independent tracks.

**None of Fongeallaz et al, Filiczkowski or Nakagawa et al Provides any Motivation**

The existence of a motivation to combine the teachings of references is a basic requirement for a rejection based on obviousness, and the burden for demonstrating such motivation is on the Examiner. *In re Kahn*, 441 F.3d 977 (Fed. Cir, 2006). Specifically, the Examiner has not demonstrated how and why and with what motivation one of ordinary skill would modify Fongeallaz in a significant way to attempt to incorporate features of a printed board game on a matrix display device, where the combination is technically and practically undesirable. How and why this would be done without undue experimentation and the impermissible use of hindsight based upon Appellant's own teachings has not been addressed by the Examiner.

Although the burden is on the Examiner, Appellant can demonstrate the absence of such motivation. Specifically, everything in Fongeallaz et al, Filiczkowski and Nakagawa, taken alone or in combination, points in the opposite direction, away from their combination, due to incompatibilities and a lack of even a common game protocol or theme. There is no motivation for modifying Fongeallaz to increase the options and activity in the Fongeallaz game, as many technical limitations would preclude such modification, including size of the screen, processing ability, etc. Further, there are many operational reasons why such change would not be obvious including the absence of any clear identification of a player's interest in multiple choices and additional complex and confusing game structures, especially for the primitive game in Fongeallaz. Further, there is no reason to modify Nakagawa, as it too is focused on a compact board presentation and does not consider the use of different track surfaces. In the absence of any teaching or suggestion for a modification of the references to add concurrent separate and distinct tracks, a passageway between the tracks, and physical running models, as claimed, there is no motivation for making the modification, other than hindsight based on Appellant's own disclosure.

**Appellant Has Rebutted Any *Prima Facie* Case of Obviousness**

In MPEP §2144.05, it is made clear that an Appellant can rebut even a *prima facie* case of obviousness by showing that the art, in any material respect, teaches away from the claimed

invention, citing *In re Geisler*, 43 USPQ2d 1362, 1366 (Fed. Cir. 1997). MPEP §2145 notes that a prior art reference that teaches away from the claimed invention is a significant factor to be considered in determining obviousness. The foregoing discussion demonstrates the absence of expressly claimed limitations and the absence of any teaching, suggestion or motivation to combine.

The Examiner has cited the case of *In re Keller*, 208 USPQ 871 (CCPA 1981) as supporting his position that the Appellant's arguments against the references individually are not a basis for showing unobviousness. However, the thrust of the Appellant's arguments are not against the references individually, other than to demonstrate that none teaches express claim limitations. Appellant's argument is that there is no basis for their combination.

In sum, Appellant respectfully submits that no reference teaches the further added feature of a passageway for conveying a running model from one concurrently existing racetrack to another, where the running model can be moved from one type of track in which the running model has a first current ability parameter to a second track where the running model's current ability parameter may have a different compatibility with the second track. The claim clearly indicates that the running model runs based on a current ability parameter in accordance with the respected tracks. Thus, the use of a physical passageway presents a significant feature of the game that is not taught by or even obvious from the teachings of any of the cited prior art.

**Dependent Claims 4, 11 and 18**

These claims specify that there are both a turf track and a dirt track in the computerized game of claims 1, 8 and 15. The characteristics of the tracks are different and the adaptation of the running models to the two types of track surfaces would be unique and is not taught in the prior art. Appellant's advance over that art is significant, in that it concurrently presents two separate and independent tracks in an electronic game environment and presents players with an opportunity to select those of the games and tracks on which they will run their racing models. Nothing of this sort is taught in Fongellaz et al or suggested in Filiczowski, as already noted. There is no teaching, suggestion or motivation to add these two types of tracks on a common board.

**Dependent Claims 2, 3, 9, 10, 16 and 17**

As to the dependent claims 2, 3, 9, 10, 16 and 17, the Examiner admits that Fongellaz et al fails to teach entire tracks where the current ability parameter of the running model is maximized or minimized. This deficiency is not made up by anything in the manual game board in Filiczowski. First, the patent to Filiczowski does not teach running models, as that term is used to represent electronically moveable pieces in the environment of a computerized game system (as claimed, “caused to run a race”). The claimed running models have calculated parameters that are maximized and minimized, and would not be suggested by a static board game that is operated only with mental and manual processes of a player.

**Dependent Claims 6, 13 and 20**

With regard to claims 6, 13 and 20, which are directed to concentric tracks, the illustration in Filiczowski would not suggest a concentric track in a planar array as seen in Fongellaz et al. There is no teaching as to how any such concentric track would be designed or implemented electronically or mechanically. This rejection is based only on Appellant’s teachings. Similarly, the claims directed to tracks having different attributes that exist concurrently, are not taught.

**Independent Claim 22**

Claim 22 already specifies two different types of tracks in which the conditions of the tracks, that is, their surface characteristics and not just the length, can be adjusted. In particular, claim 22 expressly defines the two concurrent tracks as a dirt and a turf track. The concurrent presentation of these two tracks on a single field of an electronic game is not obvious as it is not suggested in the art. The board game in Filiczowski is not relevant art, as it does not and need not contemplate the technical and operational challenges related to presentation of two types of track surfaces in an electronic game environment. The two references with electronic games that are applied by the Examiner teach only one track surface at a time. Appellant’s advance over that art is significant, in that it concurrently presents two separate and independent tracks with different surfaces and different challenges in an electronic game environment, and presents players with an opportunity to select those of the games and tracks on which they will run their

racing models. The ability to adjust the condition of a track is not taught in any reference. This claim would be patentable for these reasons and those related to the incompatibility of the cited references and the lack of teaching or motivation to provide the two claimed variable track surfaces in an electronic game environment.

Clearly, express limitations in the claims are not found in the references, and there is no teaching, suggestion or motivation to add these two types of tracks, as claimed, on a common game display.

**Dependent Claim 29**

Claim 29 requires the tracks of claim 1 to have “variable and selectable turf or soil conditions.” Appellant notes with respect to claim 29 that the Examiner asserts that Filiczkowski’s tracks are variable, in that either a region labeled grass or turf may be selected, and selectable turf or soil conditions, in that inner or outer regions may be selected. Appellant submits that selecting inner or outer tracks, even if taught, is not a selection of turf or soil conditions, as supported by the disclosure at page 23, where turf conditions include “depth, hardness, roughness and the like” while soil conditions include “viscosity and the like”. Nothing of this sort is taught in Filiczkowski or any of the other references. The claim should be patentable for the reasons given for parent claim 1 and on the basis that the prior art fails to teach or suggest the express limitation in the claim.

In short, the Appellant strongly believes that the invention as defined in the independent claims is clearly patentable over the references alone or in combination.

**ISSUE 2 - Claims 23 and 28 are not unpatentable over Fongcellaz (5,186,460) in view of Filiczkowski (5,106,098) and Nakagawa et al (EP 0757917) and further in view of Ikeda et al (6,371,854) under 35 U.S.C. §103(a).**

**Dependent Claim 23**

Rejected claim 23 depends from claim 22 and recites a game value adding device. This claim would be patentable for reasons given with respect to claim 22. Ikeda et al does not

remedy the deficiencies of the other three references, particularly with respect to the ability to adjust the condition of a track surface.

**Dependent Claim 28**

Claim 28 depends from claim 1 and specifies that the ability parameters correspond to the plurality of tracks and are based upon prior training of the physical running model on one or more of the tracks. First, Ikeda et al does not remedy the deficiencies of Fongcellaz, Filiczkowski and Nakagawa et al with respect to the features of claim 1. The Examiner has not cited Ikeda for such purpose. Ikeda et al is cited solely for purposes of teaching that players may raise and train their own horses (running models). The Examiner asserts that the training includes running races and recording the result of the race in the horse library of information, with reference to the disclosure at col. 11, lines 23-25 and 44-61. No other teaching related to racing is provided and the remainder of Ikeda mainly concerns general operation of the game machine. The Examiner notes that Fongcellaz teaches storing a "library" of data concerning attributes and abilities of running models (col. 5, lines 50-62) and suggests that the raising and running of the horses, as taught by Ikeda, could be used in Fongcellaz.

Even if this assertion is accepted, there is no teaching of the claimed structure of two concurrent tracks with different characteristics and the ability of a given horse to run on both tracks according to ability factors related to the track conditions, and the use of a passageway for transferring a horse between tracks, as recited in claim 1.

In short, the advance developed by the Appellant in displaying or presenting two tracks concurrently on a electronic or computer-driven game so that additional options and exciting opportunities exist for the game players is not obvious from viewing the single track in Fongcellaz, a simple board in Filiczkowski, a shared track in Nakagawa et al and a general game in Ikeda.

**ISSUE 3 - Claim 27 is not unpatentable over Fongcellaz (5,186,460) in view of Filiczkowski (5,106,098) and Nakagawa et al (EP 0757917) and further in view of Girardin (4,874,177) under 35 U.S.C. §103(a).**

An underlying principle of the invention as established in parent claim 1 is that the players of the claimed computerized game system have available to them a plurality of tracks (12, 13) that represent different running surfaces requiring different running abilities, such as turf, dirt or steeplechase. The physical running model is defined to have such variable running ability, which may be more compatible with one track over another. The same physical running model may move from one track to another and race on those different surfaces. Claim 27 further specifies as an additional key feature of the invention that the player may select one or more horses for his "stable", each horse having different characteristics such as stamina, speed or normal ability. Further, a player can train his horse or enhance its ability by successfully running the horse in races. Finally, the models are displayed as a list at least on the basis of ownership and are selectable on the basis of type of track. In short, the game is intended to have a player engaged for a long period of time, playing with multiple horses in the stable, whose abilities are varied and changeable based upon training, success and the like.

The rejected claim depends from claim 1 and further states that "said physical running model is a selected one physical running model taken from a plurality of physical running models that differing [sic differ] on the basis of inherent ability parameters, said plurality of physical running models being displayed as list at least on the basis of ownership and said selected one physical running model being eligible for selection from said list according to the type of track.."

The Examiner admits that Fongeallaz, Filiczkowski and Nakagawa fail to teach this feature. The Examiner relies on teachings of Girardin in the Abstract and Fig. 8 for this feature. The Examiner asserts that this allows a player to choose a horse that the player believes will have the best chance to win.

Appellant notes that the reference concerns a dice-based horse racing game in which two types of tracks are used, a dirt track 14 and a turf track 16 and the horses are represented by markers 66, the moves are determined by a variety of charts and cards 92. In this latter regard, Fig. 8 and Fig. 9A provide information about the individual horses and the track conditions, respectively. However, the game is not operated automatically, under computer control.

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In support of the patentability of the claim, Appellant respectfully submits that the display is not of the combination of a display of plural models by ownership and ability, along with a type of track. In sum, claim 27 discloses features that are not found in Fongeallaz, Filiczowski and Nakagawa, by the Examiner's admission, and are not found in Girardin as demonstrated above..

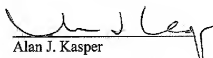
*Conclusion*

Appellant respectfully submit that they have demonstrated that the widely divergent teachings in the five cited references do not teach express limitations in the claims on appeal, are not combinable, and any proposed combination is not supported by a teaching or suggestion in the references or the knowledge of one skilled in the art.

Unless a check is submitted herewith for the fee required under 37 C.F.R. §41.37(a) and 1.17(c), please charge said fee to Deposit Account No. 19-4880.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

  
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WASHINGTON OFFICE

23373

CUSTOMER NUMBER

Date: September 20, 2006

**CLAIMS APPENDIX**

CLAIMS 1-4, 6, 8-11, 13, 15-18, 20 and 22-29 ON APPEAL:

1. A computerized game system, comprising:  
a racing field formed on a predetermined board;  
a physical running model, to which an inherent ability parameter varying in accordance with a given environment is assigned, caused to run a race on the racing field,  
wherein the racing field comprises a plurality of tracks concurrently existing on said board on which the running model runs based on a current ability parameter, in accordance with the respective tracks; and  
a physical passageway formed between the plurality of concurrently existing tracks so that the running model can enter and exit between the tracks, and the same running model can run in races on the plurality of tracks,  
wherein said ability parameter is changed according to a movement of the running model from one of said plurality of tracks to another of said plurality of tracks through the physical passageway.
2. The game system of claim 1, wherein one of the tracks is a region maintained so that the running model performs steady running in which a current ability parameter of the running model is maximized, and the other one of the tracks is a region formed so as to obstruct the steady running.
3. The game system of claim 1, wherein one of the tracks is a flat region maintained not to obstruct the running of the running model, and the other one of the tracks is a region in which obstacles are arranged on part of a track on which the running model runs.
4. The game system of claim 1, wherein one of the tracks is a region simulating a turf course, and the other one of the tracks is a region simulating a dirt course in which soil is exposed.
5. (canceled).

6. The game system of claim 1, wherein the plurality of tracks form concentric racing courses.

7. (canceled).

8. A computerized game system, comprising:  
a racing field formed on a predetermined board;  
a physical running model, to which an inherent ability parameter varying in accordance with a given environment is assigned, caused to run a race on the racing field,

wherein the racing field comprises a plurality of tracks concurrently existing on said board which provide the running model with variable factors of the ability parameter, the variable factors differing in accordance with running of the running model on the respective tracks; and

a physical passageway formed between the plurality of tracks so that the running model can enter and exit between the tracks, and the same running model can run in races on the plurality of tracks,

wherein said ability parameter is changed according to a movement of the running model from one of said plurality of tracks to another of said plurality of tracks through the physical passageway.

9. The game system of claim 8, wherein one of the tracks is a region maintained so that the running model performs steady running in which a current ability parameter of the running model is maximized, and the other one of the tracks is a region formed so as to obstruct the steady running.

10. The game system of claim 8, wherein one of the tracks is a flat region maintained not to obstruct the running of the running model, and the other one of the tracks is a region in which obstacles are arranged on part of a track on which the running model runs.

11. The game system of claim 8, wherein one of the tracks is a region simulating a turf course, and the other one of the tracks is a region simulating a dirt course in which soil is exposed.

12. (canceled).

13. The game system of claim 8, wherein the plurality of tracks form concentric racing courses.

**14. (canceled).**

15. A computerized game system, comprising:

a racing field formed on a predetermined board;

a plurality of physical running models, to each of which an inherent ability parameter varying in accordance with a given environment is assigned, caused to run a race on the racing field,

wherein the racing field comprises a plurality of tracks concurrently presented on said board on which each of the running models runs based on a current ability parameter in accordance with the respective tracks, whereby each of the running models is provided with variable factors of the ability parameter, the variable factors differing in accordance with running of each of the running models; and

a physical passageway formed between the plurality of tracks so that the running model can enter and exit between the tracks, and the same running model can run in races on the plurality of tracks,

wherein said ability parameter is changed according to a movement of the running model from one of said plurality of tracks to another of said plurality of tracks through the physical passageway.

16. The game system of claim 15, wherein one of the tracks is a region maintained so that the running model performs steady running in which a current ability parameter of the running model is maximized, and the other one of the tracks is a region formed so as to obstruct the steady running.

17. The game system of claim 15, wherein one of the tracks is a flat region maintained not to obstruct the running of the running model, and the other one of the tracks is a region in which obstacles are arranged on part of a track on which the running model runs.

18. The game system of claim 15, wherein one of the tracks is a region simulating a turf

course, and the other one of the tracks is a region simulating a dirt course in which soil is exposed.

**19. (canceled).**

20. The game system of claim 15, wherein the plurality of tracks form concentric racing courses.

**21. (canceled).**

22. A computerized game system for holding a race by causing a running image, to which an inherent ability parameter whose value varies in accordance with a given environment is assigned, to run a race on an electronically-formed racing field image, wherein

the racing field comprises a plurality of tracks in which the result of processing the current ability parameter using processes differing in accordance with the respective tracks is reflected, the tracks providing the running image with variable factors of the ability parameter, the variable factors differing in accordance with running of the running image, and wherein

one of the tracks is a region simulating a turf course, the other one of the tracks is a region simulating a dirt course in which soil is exposed, in which the condition of the turf in the track simulating the turf course and the condition of the soil in the track simulating the dirt course can be adjusted.

23. The game system of claim 22, further comprising a game value adding device which adds a game value in accordance with a result of the race.

24. The game system of claim 1, wherein each track has a different surface.

25. The game system of claim 8, wherein each track has a different surface.

26. The game system of claim 15, wherein each track has a different surface.

27. The game system of claim 1, wherein said physical running model is a selected one physical running model taken from a plurality of physical running models that differing on the basis of inherent ability parameters, said plurality of physical running models being displayed as a list at least on the basis of ownership and said selected one physical running model being eligible for selection from said list according to the type of track.

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28. The game system of claim 1, wherein said ability parameters correspond to each of said plurality of tracks and are based upon prior training of said physical running model on one or more of said plurality of tracks.

29. The game system of claim 1, wherein said tracks have variable and selectable turf or soil conditions.

**30. EVIDENCE APPENDIX:**

Pursuant to 37 C.F.R. § 41.37(c)(1)(ix), Appellant states that there is no evidence submitted pursuant to 37 C.F.R. §§ 1.130, 1.131, or 1.132 or any other evidence entered by the Examiner and relied upon by Appellant in the appeal.

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**RELATED PROCEEDINGS APPENDIX**

Pursuant to 37 C.F.R. § 41.37(c)(1)(ii), Appellant states that there are no decisions rendered by a court or the Board in any proceeding identified in Section II.

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re application of

Docket No: Q63180

Kazuhiro KUSUDA

Appln. No.: 09/783,096

Group Art Unit: 3714

Confirmation No.: 4487

Examiner: Corbett B. Coburn

Filed: February 15, 2001

For: HORSE RACING GAME WITH VARIED TRACK ATTRIBUTES

SUBMISSION OF APPEAL BRIEF

MAIL STOP APPEAL BRIEF - PATENTS

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

Submitted herewith please find an Appeal Brief. The statutory fee of \$500.00 is being charged to Deposit Account No. 19-4880 via EFS Payment Screen. The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account. A duplicate copy of this paper is attached.

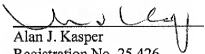
Respectfully submitted,

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Date: September 20, 2006